



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of )  
Collins, et. al )  
Assignee: Bank of America Corp. )  
Serial Number: 09/611,320 )  
Filing Date: July 6, 2000 )  
For: Card with Increased )  
Gripability )

Art Unit: 3722  
Examiner: W. Fridie

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**APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)(1)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The following reply brief is submitted pursuant to 37 C.F.R. § 1.193(b)(1) in support of the Appeal filed September 20, 2002, and specifically in response to the Examiner's Answer mailed January 30, 2004.

**II. RELATED APPEALS AND INTERFERENCES**

In order to clarify the record in this appeal, appellant would like to point out that while the Examiner's Answer indicates that the Supplemental Appeal Brief does not contain a statement regarding related appeals and interferences (Examiner's Answer at 2), such a statement is included at page 2 of the Supplemental Appeal Brief filed September 30, 2003. As stated in the Supplemental Appeal Brief, there are no other appeals or interferences

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known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.<sup>1</sup>

### **VII. GROUPING OF CLAIMS**

The Examiner's Answer states that the Supplemental Appeal Brief indicates that the claims do not stand or fall together. (Examiner's Answer at 2.) However, on page 4 of the Supplemental Appeal Brief, appellant stated, and herein re-affirms, that the claims do stand or fall together.<sup>2</sup>

### **VIII. ARGUMENT**

#### **A. The '510 Reference Does Not Anticipate Claim 24.**

In his Answer, the Examiner fails to respond in any meaningful way to the novelty arguments presented in the Supplemental Appeal Brief. There, appellant demonstrated that PCT Publication No. WO 93/11510 ("the '510 reference") merely discloses a card with a "peak and a notch" extending along the length of the card, and not a crater as claimed. (Supplemental Appeal Brief at 6.) A crater is not simply any structure with raised and indented portions, but a structure with a "lip" and a "center" as recited in claim 24. The Examiner has not provided any response to this argument, and simply continues to assert that the "peak and notch" of the '510 reference is a "crater," which appellant has demonstrated is not the case.

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<sup>1</sup> Appellant wishes to note that the identical statement was also contained in the Brief on Appeal filed November 19, 2002.

<sup>2</sup> This statement was also included in the Brief on Appeal filed November 19, 2002.

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Moreover, appellant respectfully submits that the Examiner's reference to the issue of "analogous art" (Examiner's Answer at 4) -- an argument that was not raised in the Supplemental Appeal Brief -- is inapposite. Appellant's argument does not rely on demonstrating that the '510 reference is not analogous art. Rather, appellant's argument is that the '510 reference itself does not disclose each and every element found in the claim, and therefore cannot anticipate the claimed invention. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d (BNA) 1051, 1053 (Fed. Cir. 1987).

**B. The '510 Reference Does Not Render Claim 24 Unpatentable Under 35 U.S.C. § 103.**

The Examiner further fails to respond in any meaningful way to the arguments presented in the Supplemental Appeal Brief that the '510 reference does not render the claimed invention obvious. (Supplemental Appeal Brief at 6-7.) Notably, the Examiner fails to address the point that there would be no motivation to modify the card disclosed in the '510 reference to provide craters as claimed because it would no longer work for its intended purpose -- as a key for locks in hotels and the like. The Examiner further fails to address the point that the purpose of these projections/recesses in the '510 reference has nothing to do with enhancing the gripability of the card.

Finally, appellant respectfully submits that the '510 reference is structurally different from the claimed inventions and therefore the Examiner's citation to *In re Casey*, 152 U.S.P.Q. 235 (C.C.P.A. 1967) and *In re Otto*, 136 U.S.P.Q. 458 (C.C.P.A. 1963) is inapposite.

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CONCLUSION

In view of the above discussion, appellant respectfully urges that the rejection of claims 24-33 as unpatentable under 35 U.S.C. §§ 102(b) or 103 is improper. Reversal of the rejections in this appeal is respectfully requested.

Dated: March 15, 2004

Respectfully submitted,

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